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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/074,132	02/12/2002	Scott Frederick Ansell	VTN-0577	8163

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EXAMINER

HECKENBERG JR, DONALD H

ART UNIT	PAPER NUMBER
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1722

DATE MAILED: 07/14/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/074,132

Applicant(s)

ANSELL ET AL.

Examiner

Donald Heckenberg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-33 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 20-33 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3,5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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1. The continuity data at the beginning of the specification needs to be updated to reflect that U.S. App. No. 09/476,273, to which the instant application claims priority, has issued as U.S. Pat. No. 6,368,522.

Page 2 of the specification also needs to be updated to indicate the Serial Number of the referenced application at line 6.

2. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 47-⁶⁰~~59~~ been renumbered as 20-³³~~32~~. Note, only claims 1-19 had been previously pending in the application, thus the first new claim has been renumbered as 20. Reference below will be made to the renumbered claims.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 20-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Claim 20 recites the limitation "said mold material" in line 2. There is insufficient antecedent basis for this limitation in the claim. The term "mold material" could be understood to mean two completely different things to one of ordinary skill in the art. "Mold material" could refer to the material being molded in the mold that forms the contact lens product. On the other hand, "mold material" could refer to the material that the mold structures are actually made from. Accordingly, as used in this claim, "said mold material" is indefinite. Based on the disclosure of the instant application, it is believed more likely Applicant intended "mold material" to mean the material from which the mold structure is made, and the claim will be interpreted as such below. However, appropriate clarification and correction is required.

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5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 20-22 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Su et al. (U.S. Pat. No. 5,574,554).

Su discloses a mold for forming a contact lens. In the embodiment shown in figure 14 the mold comprises an ring-shaped overflow collector (38). The overflow connector is made from a

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different material the material of the mold portion it is attached to (column 9, lines 16-29).

Su further discloses the mold (3)- and overflow collector (38) to be used with another mold structure (2). The overflow collector (38) and mold (3) are removable from the mold structure (2) when the mold is opened (column 8, lines 34-36).

Claim 22 recites an intended use of the apparatus claimed, specifically that the mold is reusable. It is well settled that the intended use of an apparatus is not germane to the issue of patentability of the apparatus. If the prior art structure is capable of performing the claimed use, then it meets the claim limitation(s). In re Casey, 370 F.2d 576, 580 152 USPQ 235, 238 (Cust. & Pat. App. 1967); In re Otto, 312 F.2d 937, 939, 136 USPQ 458, 459 (Cust. & Pat. App. 1963). In the instant case, the structure of the mold of Su is such that the mold could be reused, and there is nothing in the disclosure of Su suggesting otherwise. Accordingly, Su anticipates claim 22.

7. Claims 20, 24-27, and 29-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Appleton et al. (U.S. Pat. No. 5,271,875; previously of record).

Appleton discloses a mold for making contact lenses. In the embodiment shown in figures 14-15, the mold comprises an ring-

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shaped overflow collector (53) as part of structure (20). The overflow collector, in being part of structure (20), is made from a different material than the mold structure (21) (see column 6, lines 4-29). Appleton further discloses that one of the materials that the structure (20) including overflow collector (53) can comprise is rubber (column 6, lines 16-21). As shown in figure 15, the overflow collector, including the excess molding material (61), can be removed from the mold (21).

Claim 27 recites that the mold is reusable. Claim 30 recites that the structure is disposable. These limitations are directed towards the intended use of the apparatus. As noted above, the intended use of an apparatus is not germane to the issue of patentability. The structure of the mold of Appleton is such that the mold could be reused or disposed of after a use, and there is nothing in the disclosure of Appleton suggesting otherwise. Accordingly, Appleton anticipates claim 27.

8. Claims 31-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Doke et al. (U.S. Pat. No. 6,071,111; previously of record).

Doke discloses a mold for making contact lenses. In the embodiment shown in figure 17, the mold comprising a first mold portion (4), a second mold portion (8), and a third mold portion

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(6). The third mold portion comprises an overflow collector

(82). The overflow connector is inserted between flanges on the first and second mold portions (see figure 17).

Claim 33 recites that the overflow connector is disposable. This limitation is directed toward the intended use of the apparatus. As noted above, the intended use of an apparatus is not germane to the issue of patentability. In the instant case, the apparatus of Doke is such that the overflow collector could be operated in a manner to be disposable by simply replacing the third portion (6) with an identical portion. As such, claim 33 is anticipated by Doke.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 23 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Su et al.

Su discloses the contact lens molding apparatus as described above. Notably, Su discloses the overflow collector (38) to be made from a polar material in order to adhere to the molded lens (column 9, lines 24-29). Su further discloses that

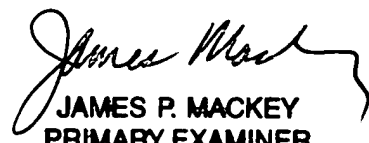
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polystyrene is a know polar material from which portion of the mold may be constructed (column 7, lines 52-56). Accordingly, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have used polystyrene as the material from which the overflow collector constructed because, as Su notes, polystyrene is a polar material known in the art to construct portions of the mold from.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Heckenberg whose telephone number is (703) 308-6371. The examiner can normally be reached on Monday through Friday from 9:30 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker, can be reached at (703) 308-0457. The official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310 for responses to non-final action, and 703-872-9311 for responses to final actions. The unofficial fax phone number is (703) 305-3602.


Donald Heckenberg
July 7, 2003


JAMES P. MACKEY
PRIMARY EXAMINER
7/9/03